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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/482,773    01/13/00    DREHER    J    2870/220

026646  
KENYON & KENYON

HM22/1030

ONE BROADWAY  
NEW YORK NY 10004

EXAMINER

BERMAN, A

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

10/30/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/482,773

Applicant(s)

DREHER, JOHN D.

Examiner

Alysia Berman

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1619

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

**DETAILED ACTION**

1. Receipt is acknowledged of the amendment filed September 17, 2001. Claims 20 and 21 have been amended. Claims 1-34 are pending.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 6, 12-14, 17-20, 24, 32 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claims 6, 12-14, 17-20 and 24 are indefinite because of the term "non-matte".

This rejection is maintained for reasons of record in paper no. 3.

5. Claims 32 and 33 are indefinite because they contain percents of components but do not provide units of measurement. This rejection is maintained for reasons of record in paper no. 3.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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7. Claims 1-8 and 12-17 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,690,916 (916, Kimura et al.).

This rejection is maintained for reasons of record in paper no. 3.

8. Claims 1-5, 9, 21-23, 25, 26 and 29 are rejected under 35 U.S.C. 102(e) as being anticipated by WO 99/66883 (883).

This rejection is maintained for reasons of record in paper no. 3.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over either US 5,690,916 (916) or WO 99/66883 (883) each in view of the other.

This rejection is maintained for reasons of record in paper no. 3. The Examiner inadvertently left claims 31-34 out of the original rejection. However, it is clear from the rejection how the references apply to claims 31-34 since they contain limitations that are equivalent to or overlap the limitations of claims 9 and 18-21.

***Response to Arguments***

11. Applicant's arguments filed September 17, 2001 have been fully considered but they are not persuasive.

12. Applicant argues that the term "non-matte" is sufficiently defined in the specification. Whether or not a powder confers a matte finish is relative. The examples

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and preferred embodiments in the specification are not exclusive. Applicant has not provided any guidance of how to measure or determine whether a powder is non-matte.

The explanation bridging pages 4 and 5 is based on relative terms that are not further defined. What does Applicant intend by an overt shine and a muted reflectance?

Therefore, the metes and bounds of the claims cannot be determined.

13. Applicant argues that neither US '916 or WO '883 teach a method of reducing fine lines and wrinkles. The method instantly claimed is the step of applying the composition to the skin, which both references teach. The instantly claimed methods do not required application to lined or wrinkled skin. WO '883 discloses in the abstract that the compositions reduce the appearance of flaws and defects in the skin. Flaws and defects encompass lines and wrinkles. Reducing the appearance of lines and wrinkles on the skin as written in the instant claims is the purpose or result of the method of applying the composition, not the actual method itself, and is not given patentable weight. Additionally, since all skin has lines and/or wrinkles, application of a composition containing the same components as instantly claimed inherently reduces the appearance of the lines and wrinkles.

14. Applicant argues that WO '883 does not teach a composition containing an interference pigment with a blue or violet reflectance. WO '883 is directed to compositions that must contain at least one interference pigment. WO '883 discloses the same pigments as disclosed by Applicant as interference pigments. All disclosures in a reference patent must be evaluated, including non-preferred embodiments. A

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reference is not limited to disclosure of the specific working examples. See *In re Mills* 176 USPQ 196 (CCPA 1972). WO '883 is not limited to the disclosed examples.


***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alysia Berman whose telephone number is 703-308-4638. The examiner can normally be reached during core hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana Dudash can be reached on 703-308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3592 or 703-305-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234 or 703-308-1235.

  
Alysia Berman  
Patent Examiner  
October 24, 2001

  
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